

REMARKS/ARGUMENTS

Initialed PTO-1449 Forms

As an initial matter, the Office Action mailed March 5, 2004 enclosed a copy of the PTO-1449 form submitted with the Information Disclosure Statement of July 29, 2002. While most of the references listed in the PTO-1449 form were initialed by the Examiner, the reference entitled "International Search Report in International (PCT) Application No. PCT/US 02/09966 dated March 28, 2002" was not initialed as having been considered by the Examiner. To ensure that the references listed on the above-referenced PTO-1449 form appear on the face of the patent that issues from this application, applicants respectfully request that the Examiner initial all references cited in the PTO-1449 form and return a copy of the initialed form to applicants' attorney of record, Marshall, Gerstein & Borun LLP.

Status of Application

In the Office Action mailed March 5, 2004, each of the independent claims were rejected under §102(b) as being anticipated by U.S. Patent No. 6,012,983 to Walker, et al. or alternatively by U.S. Patent No. 6,093,102 to Bennett.

In the above amendments, claims 1, 12, 23, 33 and 41-45 have been amended. In view of above amendments and the following remarks, reconsideration of the application is respectfully requested.

Walker et al. §102 Rejection

Claims 1-32

Independent claims 1, 12 and 23 each include, *inter alia*, the following recitations:

said controller being programmed to allow a person to make a wager on an occurrence of a wagering game,

said controller being programmed to receive data relating to a request from said person **made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,**

said controller being programmed to make an automated selection from among said plurality of user-selectable options in response to said request,

As should be apparent from the plain language of each of independent claims 1, 12 and 23, each of claims 1, 12 and 23 are directed to a gaming apparatus having a controller that is programmed to (1) allow a person to make a wager on an occurrence of a wagering game, (2) receive data relating to a request from a person made during the occurrence of the wagering game for the controller to make an automated selection from among a plurality of user-selectable options presented to the person, and (3) to make an automated selection from among the plurality of user-selectable options in response to the request.

The Walker, et al. patent generally discloses a gaming device in which a player selects automated play and enters player parameter selections which are stored in the gaming device to automatically execute a series of occurrences of the game at the gaming device. (Walker et al. Col. 7, lines 43-44; Col. 8, lines 3-4). The player parameters entered by the player include play options and limiting criteria of play. (Walker et al. Col. 8, lines 15-21). Player parameters entered by the player may also include decision rules which dictate the course of play based upon the current status of play. (Walker et al. Col. 13, lines 7-18). The gaming device proceeds to initiate automated play of the gaming device according to the player parameters selected by the player without the need for player intervention or selection during or between the occurrences of the game. (Walker et al. Col. 8, line 62).

However, nowhere in the Walker et al. patent does it appear to disclose or suggest receiving data relating to a request from the player made during an occurrence of the wagering game for the controller to make an automated selection of user-selectable options that are presented to the player and making an automated selection in response to the request. The Office Action states that Fig. 8 of Walker et al. discloses a controller configured so as to "select a gaming option automatically from a plurality of user-selectable options." This figure of the Walker et al. patent and its description, as well as the whole of the Walker et al. patent, however, appears to only disclose allowing a player to select player parameters, such as play options and decision rules, and generate outcomes without further input from the player during an occurrence of the wagering game. While the Walker et al. patent receives a request for automated play prior to a series of occurrences of a wagering game, the Walker et al. patent does not receive data relating to a request from the player for the controller to make an automated selection, where the request from the player is made during an individual occurrence of a wagering game. For example, the player only requests the gaming device to automatically generate outcomes during a series of occurrences of the wagering game based on player parameters selected beforehand by the player. (Walker et al. Col. 7, lines 43-44).

Once the player has selected the player parameters, the gaming device initiates an automated play session and automatically generates outcomes based on the player-selected player parameters without further input from the player. (Walker et al. Col. 9, lines 1-24). The gaming device continues to generate outcomes for a series of occurrences of the wagering game based on the player-selected player parameters until a limiting criteria occurs. (Walker et al. Col. 10, line 52 to Col. 11, line 10). In other words, the Walker et al. patent does not appear to receive a request from the player during an individual occurrence of the wagering game for the controller to make an automated selection of user-selectable options presented to the player, and the gaming device does not make an automatic selection in response to such a request. Therefore, it is respectfully submitted that claims 1, 12 and 23, and claims 2-11, 13-22 and 24-32 which respectively depend therefrom, are allowable over Walker et al.

Claims 33-40

Independent claim 33 is directed to gaming method that includes (1) allowing a person to make a wager on an occurrence of a wagering game, (2) receiving data relating to a request from the person made during the occurrence of the wagering game to make an automated selection from among a plurality of user-selectable options presented to the person, and (3) performing an automatic selection from among the plurality of user-selectable options in response to the request.

It is respectfully submitted that Walker et al. does not appear to disclose or suggest a gaming method that includes (1) allowing a person to make a wager during an occurrence of a wagering game, (2) receiving data relating to a request from a person made during an occurrence of a wagering game to make an automated selection from among a plurality of user-selectable options presented to the person during the occurrence, and (2) performing an automatic selection from among the plurality of user-selectable options in response to the request.

As discussed in greater detail above with respect to claims 1, 12 and 23, Walker et al. appears to only disclose automatically generating outcomes based on player parameters previously selected by the player, and not performing an automatic selection in response to a request made by a player during an occurrence of the wagering game. Therefore, it is respectfully submitted that claim 33, and claims 34-40 which depend therefrom, are allowable over Walker et al.

Claims 41-45

Claim 41 is directed to a memory that includes (1) a first memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to allow a person to make a wager on an occurrence of a wagering game, (2) a third memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to receive data relating to a request from a person **made during the occurrence of the wagering game for the controller to make an automated selection** from among a plurality of user-selectable options presented to the person, and (3) a fourth memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to perform an automated selection from among the plurality of user-selectable options in response to the request.

It is respectfully submitted that Walker et al. does not appear to disclose or suggest a memory that includes memory portions physically configured in accordance with computer program instructions that would cause a gaming apparatus to (1) receive data relating to a request from a person made during an occurrence of a wagering game for the controller to make an automated selection from among a plurality of user-selectable options presented to the person, and (2) perform an automated selection from among the plurality of user-selectable options in response to the request.

As discussed in greater detail above with respect to claims 1, 12 and 23, Walker et al. appears to only disclose causing a gaming apparatus to automatically generate outcomes based on player parameters previously selected by the player, and not causing a gaming apparatus to perform an automatic selection in response to a request made by a player during an occurrence of the wagering game. Therefore, it is respectfully submitted that claim 41, and claims 42-45 which depend therefrom, are allowable over Walker et al.

Bennett §102 Rejection

Claims 1-32

Independent claims 1, 12 and 23 are each directed to a gaming apparatus having a controller that is programmed to: (1) receive **data relating to a request** from a person made **during an occurrence of a wagering game for the controller to make an automated selection** from among a plurality of user-selectable options presented to the person, and (2) **make an automated selection** from among the plurality of user-selectable options **in response to the**

request. As should be apparent from the plain language of each of independent claims 1, 12 and 23, the controller of each of claims 1, 12, and 23 receives data relating to a request from a person for the controller to make an automated selection from among a plurality of user-selectable options presented to the person. It should also be apparent that the controller is programmed to make an automated selection in response to the request.

The Bennett patent discloses a gaming machine which displays an array of symbols. A player selects the symbol positions to be included in the player's pay line combinations. If the player does not select symbol positions, the selection defaults to a center line position. (Bennett, Col. 3, line 54 to Col. 4, line 33)

It is respectfully submitted that the Bennett patent does not appear to disclose or suggest a controller that is programmed to (1) receive data relating to a request from a person made during an occurrence of a wagering game for the controller to make an automated selection from among a plurality of user-selectable options, and (2) make an automated selection from among the plurality of user-selectable options in response to the player request. As mentioned above, it appears as though the Bennett patent makes a default selection in the absence of a request by the player as opposed to making an automated selection in response to a request by the player, as recited in claims 1, 12 and 23. In other words, the Bennett patent does not appear to receive data relating to a request to make an automated selection of user-selectable options, and make an automated selection in response to the request. Therefore, it is respectfully submitted that claims 1, 12 and 23, and claims 2-11, 13-22 and 24-32 which respectively depend therefrom, are allowable over Bennett.

Claims 33-40

Independent claim 33 is directed to gaming method that includes (1) receiving data relating to a request from a person made during an occurrence of a wagering game to make an automated selection from among a plurality of user-selectable options presented to the person, and (2) performing an automatic selection from among the plurality of user-selectable options in response to the request.

It is respectfully submitted that Bennett does not appear to disclose or suggest (1) receive data relating to a request from a person made during an occurrence of a wagering game for the controller to make an automated selection from among a plurality of user-selectable options, and (2) make an automated selection from among the plurality of user-selectable options in response to the player request.

As discussed in greater detail above with respect to claims 1, 12 and 23, Bennett appears to only disclose automatically making a default selection of the center line in the absence of any request or selection from the player. Therefore, it is respectfully submitted that claim 33, and claims 34-40 which depend therefrom, are allowable over Bennett.

Claims 41-45

Claim 41 is directed to a memory that includes (1) a third memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to receive data relating to a request from a person made during an occurrence of a wagering game for the controller to make an automated selection from among a plurality of user-selectable options presented to the person, and (2) a fourth memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to perform an automated selection from among the plurality of user-selectable options in response to the request.

It is respectfully submitted that Bennett does not appear to disclose or suggest a memory that includes memory portions physically configured in accordance with computer program instructions that would cause a gaming apparatus to (1) receive data relating to a request from a person made during an occurrence of a wagering game for the controller to make an automated selection from among a plurality of user-selectable options presented to the person, and (2) perform an automated selection from among the plurality of user-selectable options in response to the request.

As discussed in greater detail above with respect to claims 1, 12 and 23, Bennett appears to only disclose causing a gaming apparatus to automatically make a default selection of the center line in the absence of any request or selection from the player. Therefore, it is respectfully submitted that claim 41, and claims 42-45 which depend therefrom, are allowable over Bennett.

Conclusion

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance. If there is any matter that the Examiner would like to discuss, he is invited to contact the undersigned representative at the telephone number set forth below.

Dated: June 4, 2004

Respectfully submitted,

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